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09/414,547	10/08/1999	TOKIMORI TOMITA	122.1046cd	3462
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STAAS & HALSEY LLP			KARMIS, STEFANOS	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/414,547	<b>Applicant(s)</b> TOMITA ET AL.
	<b>Examiner</b> STEFANOS KARMIS	<b>Art Unit</b> 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 05 May 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 101-109 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 101-109 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No.(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following communication is in response to Applicant's amendment filed 05 May 2010.

***Status of Claims***

2. Claims 1-100 are cancelled. Claims 101-106 are currently amended. Claims 107 and 108 are previously presented. Claim 109 is newly added. Therefore claims 101-109 are currently pending.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 101, 102, and 107-109 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 101 and 102, the claims are drawn to a point management system for managing service points based on a customer's transaction. However, the body of the claim fails to disclose the hardware structure the makes up the system. While the claims does have a database, the other limitations are directed to various parts, such as a point issuing part, point accumulation part, customer identification part and point sending part. Since these parts can be interpreted as software, the claim fails to disclose sufficient structure. Amending the claim to claim the appropriate hardware structure in the body of the claim, and the parts being on the

Art Unit: 3693

hardware would be sufficient to overcome the rejection. Claims 107 and 108 are dependent off claim 101 and are thus rejected based on their dependency.

Regarding newly added claim 109, the claims are drawn to a method/process for managing service points based on a customer's transaction. A method/process claim requires that the claim meet the machine or transformation test. Therefore the claimed process must: (1) be tied to a particular machine or apparatus, or (2) particularly transform a particular article to a different state or thing. Further the particular machine or transformation must involve meaningful limits and be more than insignificant extra-solution activity. Turning to independent claim 109, the claim only ties the process to a machine or apparatus in the first limitation of receiving, via a computer, transaction information... Amending the claim to encompass that the "updating" limitation is done via a computer would be sufficient to overcome this rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 101-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (hereinafter Schultz) U.S. Patent 5,056,019 in view of Deaton et al. (hereinafter Deaton) U.S. Patent 5,201,010 in further view of Nichtberger et al. (hereinafter Nichtberger) U.S. Patent 4,882,675.

Regarding claims 101-106, Shultz teaches a method for managing points issued according to transactions under identification of a customer in a system connected to a terminal via a communication link, comprising:

Identifying said customer according to customer identification information obtained from said terminal (column 9, lines 25-38 and lines 66 thru column 10, line 6; Examiner notes that the customer is identified by using their bar-coded identification code to be scanned by the in-store computer);

Issuing points according to said transactions under said identification (column 6, lines 5-27; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer);

Managing said points of said customer by calculating a balance point of said customer according to transactions performed by said customer (column 6, lines 5-12; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer and column 10, lines 20-28; Examiner notes that the central management system determines the consumer's earned rewards, page 10, paragraph 20-28);

Schultz further teaches that the in-store computer comprises a databank for storing a plurality of files including customer files containing information related to consumers participating in frequent shopper program and reward files containing information related to the purchase reward offers (column 9, lines 47-53).

Schultz teaches sending point balance to customer via a status report that comes in the mail, the status report containing information about reward amounts and different types of reward certificates, such as negotiable check, or a voucher to be redeemed at a participating store for cash or credit towards product purchases (column 8, lines 48-67).

Schultz fails to teach that the point balance is sent to the terminal after the customer identification.

Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) as taught by Deaton and Nichtberger because it allows the customer to take advantage of earned

coupons/rewards through their shopping history (previous transactions) at the point of sale when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation combine the teachings of Schultz with Deaton and Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Deaton and Nichtberger.

Claim 107, Schultz teaches that the sending is executed without requiring receipt of a request for the customer's cumulative points from the customer and in response to said identifying of the customer (column 8, lines 42-67 and column 9, lines 25-38 and lines 66 thru column 10, line 6).

Claim 108, Schultz teaches wherein said sending is executed independent and separate from performing of the transaction and in response to receipt of said customer identification information (column 8, lines 42-67).

#### *Response to Arguments*

6. Applicant's arguments with respect to claims 101-108 have been considered but are not persuasive. These arguments are similar to previous arguments. The Examiner has restated

arguments below and also elaborated on them. Applicant's amendments fail to overcome the references as discussed below. Also, a claim objection has been added as noted below.

7. Applicant argues that the cited prior art fails to teach "sending, regardless of the customer's request of sending points, the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer." The Examiner respectfully disagrees. Schultz teaches that the in-store computer system comprises an instore data bank (database) for storing a plurality of files (column 9, lines 47-59). Schultz further teaches that the files include information related to consumers participating in a frequent shopper program and reward files containing information related to the purchase reward offer (column 9, lines 47-59). Schultz further teaches that the PMCS also includes a data bank which stores reward files and customer files identical the in-store data bank (column 9, line 60 thru column 10, line 6). Schultz also teaches that the customer file stores records of purchased items with associated rewards (column 10, lines 8-19). Therefore, Schultz teaches a "a customer database for stored cumulative points." Further, Schultz teaches sending a status report, usually monthly, to the customer that details the purchase of reward products and reward amounts that have already been earned (column 8, lines 42-67). The Examiner also notes that the status report is send to the customer regardless of the customer's request since it comes on a time basis. Schultz fails to teach that the report is sent to a customer terminal after the customer identification and prior to performing a transaction by the customer.

Deaton also teaches the use of a customer database (column 68, steps 3-13). Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions

and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61). Therefore Nichtberger teaches that the coupon are delivered to the user after identifying the user (when the user's card is scanned) and prior to performing the transaction (final payment and completion of sale). Further Nichtberger teaches that coupons are retrieved when a special card or receipt number has been scanned (column 17, lines 49-52). The special card is used to identify the customer (column 17, lines 30-48). Further, Nichtberger teaches that the processor requests the corresponding list of coupons, not the customer (column 17, lines 49-53). Similarly, Applicant's claims require identifying the customer prior to sending the customer the account balance. Further, something has to request the point balance, like the system.

Therefore Applicant's argument is not persuasive and the cited prior does teach "sending, regardless of the customer's request of sending points, the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer."

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) as taught by Deaton and Nichtberger because it allows the customer to take advantage of earned coupons/rewards through their shopping history (previous transactions) at the point of sale when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation combine the teachings of Schultz with Deaton and Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Deaton and Nichtberger.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Applicant argues that the cited prior art fails to teach the amended language of specific computers being on the store side and the customer's side as well as having a point issuing part that is located separately from the customer terminal. The Examiner respectfully disagrees. Schultz teaches that the in-store computer system comprises an instore data bank (database) for storing a plurality of files (column 9, lines 47-59). This computer is located on the store side. Schultz further teaches that the PMCS also includes a data bank which stores reward files and customer files identical the in-store data bank (column 9, line 60 thru column 10, line 6). Schultz also teaches that the customer file stores records of purchased items with associated rewards (column 10, lines 8-19). Therefore, Schultz teaches a store side computer with a customer database for stored cumulative points. Further, Schultz teaches sending a status report, usually monthly, to the customer that details the purchase of reward products and reward amounts that have already been earned (column 8, lines 42-67). The Examiner also notes that the status report is send to the customer regardless of the customer's request since it comes on a time basis. Schultz fails to teach that the report is sent to a customer terminal after the customer identification and prior to performing a transaction by the customer.

Deaton also teaches the use of a customer database (column 68, steps 3-13). Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions

Art Unit: 3693

and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Examiner notes that the point of sale can be broadly interpreted as the customer's side, because it is where the customer interacts with the system. Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61). Therefore Nichtberger teaches that the coupon are delivered to the user after identifying the user (when the user's card is scanned) and prior to performing the transaction (final payment and completion of sale). Further Nichtberger teaches that coupons are retrieved when a special card or receipt number has been scanned (column 17, lines 49-52). The special card is used to identify the customer (column 17, lines 30-48). Examiner notes that the use of the card at the point of sale can be broadly interpreted as the customer's side, because it is where the customer interacts with the system.

Therefore Applicant's argument is not persuasive and the cited prior does teach "sending, regardless of the customer's request of sending points, the customer's current cumulative points stored in the customer database to the terminal prior to performing transaction by the customer based upon a result of said identifying the customer."

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
/Stefanos Karmis/  
Primary Examiner, Art Unit 3693  
9 June 2010